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09/672,152	09/27/2000	Thomas D. Nord	2094B	6622

7590 05/09/2003
Terry T. Moyer
P.O. Box 1927
Spartanburg, SC 29304

EXAMINER

LONEY, DONALD J

ART UNIT PAPER NUMBER

1772

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-17

Office Action Summary

Application No.

09/672152

Applicant(s)

Novel et al

Examiner

D. Loney

Group Art Unit

1772

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 09/31/03.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-44 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-44 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Applicant Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 51214
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, 11, 14, 16, 29 and 43 contain Markush groups wherein the members are not mutually exclusive. For example rounded and circular are not mutually exclusive, octagonal and polygonal are not mutually exclusive for the shape groups. For the design Markush groups, groups, designing patterns and strips are all not mutually exclusive since they can all be considered are in the same.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,340,514 as presented in the last Office action mailed July 19, 2002. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the foam rubber contains cylindrical protrusions, which are included within applicant's Markush Group.

Claims 1-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,420,015. Although the conflicting claims are not identical, they are not patentably distinct from each other because the star shaped protrusions are within the applicant's Markush group of polygonal.

4. Claims 1-44 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 09/679,467. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to use combination of the Markush Groups protrusions since the same ones are reacted.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-44 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-32 of copending Application No. 09/653,785. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would be obvious to use combinations of the Markush Groups protrusions since the same ones are reacted.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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6. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,296,919. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cylindrical protrusions are round in shape as in the instant Markush Group.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

8.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2, 3, 4, 5, 7, 8, 11, 27, 36, 37, 38, 39, 40 and 42-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Engst.

Engst teach a mat with form rubber layer (3) that has polygonal (i.e. square) protrusions that also contains two more solid rubber layers (10, 12). Refer to Figures 1, 2, and column 2, lines 14-34, column 4, lines 24-48 and column 5, lines 1, 2, 18-25.

The recitations as to the protrusions on the backside are met since this^{is} only a matter of which way the mat is oriented and looked at (from the top or bottom). The nubs bumps, clients or texture limitations are all met by the protrusions themselves or part thereof since this the structure thereof is not distinguishable there^{from}of.

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10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

11.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

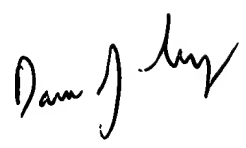
12. Claims 1, 4, 5, 8, 11, 29, 37, 38, 39, 40, 41, 43 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Cerlani.

Cerlani teaches a foam rubber with protrusions on the back and/or front surface. Again the client, rubs, bumps or texture can be considered as discussed above in relation to the protrusions. Refer to Figures 2, 3A, 3B, and 3C. Fig. 3C shows a projection, which is cylindrical at the top and tapered down there from (i.e. conical).

13. Applicant's arguments filed March 31, 2003 have been fully considered but they are not persuasive. The applicant argues that the double patenting rejections be withdrawn in view of the amendments filed March 31, 2003. This is not persuasive since the claims contain subject matter as indicated that is substantially the same (i.e. Markush Groups of the same scope except for the "combinations thereof" language).

14. Any inquiry concerning this communication should be directed to Examiner D. Loney at telephone number (703) 308-2416.

D. Loney/dh
April 22, 2003


DONALD J. LONEY
PRIMARY EXAMINER